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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/826,810

04/15/2004

Fernando Incertis Carro

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SCHMEISER, OLSEN & WATTS  
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LATHAM, NY 12110

EXAMINER

THERIAULT, STEVEN B

ART UNIT

PAPER NUMBER

2179

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/826,810	<b>Applicant(s)</b> CARRO ET AL.	
	<b>Examiner</b> STEVEN B. THERIAULT	<b>Art Unit</b> 2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

1. This action is responsive to the following communications: Non-provisional application filed 04/15/2004, which claims foreign priority to a European patent filed 04/18/2003.
2. Claims 1 -29 are pending in the case. Claim 1 is the independent claim.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 because the claim does not appear to comply with the Bilski test where the method claim is verified to clearly tie the subject matter to another class of invention or perform the transformation test. The system to which the method is tied is not clearly shown. Perhaps applicant can amend to incorporate the simple phrase of "presenting said retrieved data visually on a display or orally via audio device on the user system.

#### ***Claim Rejections - 35 USC § 102***

3. **The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1-5, 10-11, 15, 20-24, 26-27 and 29 are rejected under 35 U.S.C 102(b) as being anticipated by Carro et al. (hereinafter Carro) U.S. Patent Publication No. 20020087598 published July 4, 2002.**

**It is noted, the for critical reference date determination in this case, the U.S. filing date is used, therefore the publication qualifies as a 102(b).**

In regard to **Independent claim 1**, Carro teaches a method for use in a user system, for accessing information related to a physical document, said method comprising the steps of:

- Identifying a physical document (See Para 76,154)

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- Identifying and locating an electronic copy of said identified document (see Para 148, 165).
- Identifying one or a plurality of pages of said physical document and identifying a part of the identified physical document using the position of points on said identified pages (See Para 147, 160)
- retrieving from the electronic copy of the physical document, data related to the selected part of the document (See Para 116)
- Presenting said retrieved data visually or orally on the user system (see Para 148, 150)

With respect to **dependent claim 2**, Carro teaches the method wherein the step of identifying one or a plurality of pages of said physical document and identifying a part of the identified physical document using the position of points on said identified pages further comprises pressing said points on a touch foil successively placed and aligned over or under said identified pages (See Para 81, 112).

With respect to **dependent claim 3**, Carro teaches the method wherein said physical document and pages in said physical document are selected by a user (See Para 155, 172).

With respect to **dependent claim 4**, Carro teaches the method wherein a point on a touch foil is pressed with a fingertip or a pen (See Para 81, 112, 159).

With respect to **dependent claim 5**, Carro teaches the method wherein the step of identifying one or a plurality of pages of said physical document and identifying a selected part of the identified physical document using the position of points pressed on a touch foil successively placed and aligned over or under said identified pages, comprises the further steps of: identifying a first page in said physical document (See Para 80, 186 -187); determining the position of a first

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point pressed on the touch foil placed and aligned over or under the identified first page, said first point corresponding to the start point of a part selected in said identified document (See Para 181-183, 188 , 203-206, 210); if start point and end point of the selected part are on a same page: determining the position of a second point pressed on the touch foil placed and aligned over or under the identified page of said document, said second point corresponding to the end point of said selected part (see Para 206, 210, 220-230); if start point and end point are not on a same page: identifying a second page in said physical document; determining the position of a second point pressed on the touch foil placed and aligned over or under the identified second page of said document, said second point corresponding to the end point of said selected part. identifying the selected part of the identified physical document using the position of the start point and the end point(See Para 181-183, 188, 206, 210, 220-230).

With respect to **dependent claim 10**, Carro teaches the method wherein the electronic copy of the document is an exact replica of the physical document (see Para 127).

With respect to **dependent claim 11**, Carro teaches the method wherein the document identifier is an address to access the electronic copy of the physical document (See Para 117-118).

With respect to **dependent claim 15**, Carro teaches the method wherein the step of retrieving from the electronic copy of the document, data related to the selected part of the document; comprises the further steps of: identifying and locating information and/or services associated with the selected part of the document; and retrieving said information and/or services; reading or magnifying or playing or displaying said information and/or services on the user workstation (see Para 146-147, displaying and illuminated or highlighted).

With respect to **dependent claim 20**, Carro teaches the method wherein said user system is connected to a communication network comprising one or plurality of servers, and wherein the

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electronic copy of the physical document is located on one of said plurality of servers (Para 145, 151, 248, 224).

With respect to **dependent claim 21**, Carro teaches the method wherein the electronic copy of the physical document is located on the user system (see Para 117,, locally).

With respect to **dependent claim 22**, Carro teaches the method wherein said user system is connected to a communication network comprising one or plurality of servers, and wherein the information and/or services associated with said physical document are located on one or a plurality of said servers (see Para 145, 151, 224, 248).

With respect to **dependent claim 23**, Carro teaches the method wherein the electronic copy of the physical document and the information and/or services associated with said physical document are located on the user system (See Para 145, 151, 173, 224, 248).

With respect to **dependent claim 24**, Carro teaches the method wherein: the communication network is an Internet network; the one or plurality of servers are Web servers; and the document identifier is an internet address (See Para 145, 151, 173, 224, 248).

With respect to **dependent claim 26**, Carro teaches a user system comprising means adapted for carrying out the steps of the method according to claim 1 (See Figure 14-15).

In regard to **dependent claim 27**, Carro teaches a system comprising: a user system according to claim 26, optionally connected to a communication network; a touch foil to be placed over or under a page of a physical document for: detecting a pressure exercised over one or a plurality of point of its surface; and determining the coordinates of said one or plurality of points; and a connection between said touch foil and the user system (See Para 81, 112).

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With respect to **dependent claim 29**, Carro teaches a computer program comprising instructions for carrying out the steps of the method according to claim 1, when said computer program is executed on the user system according to claim 26 (See Figure 14-15).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. **Claims 6-9, 12-14, 16-19, 25, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carro et al. (hereinafter Carro) U.S. Patent Publication No. 20020087598 published July 4, 2002, in view of Schneider et al. (hereinafter Schneider) U.S. Patent Publication No. 20020156866 filed Apr. 19, 2001. .**

With respect to **claims 6-9, 12-14, 16-19, 25, 28** as indicated in the above discussion Carro teaches all the elements of claim 1.

Carro teaches creating an electronic copy of the physical document; associating information and/or services with said electronic copy (See Para 145, 151, 173, 224, 248), but does not expressly recite the method wherein the step of presenting said retrieved data orally, comprises the further steps of: extracting text data from said data; converting said text data into data that can be electronically read and audibly reading said text data by means of a text-to-speech system.

However, Schneider teaches a system that reads a character on a medium, recognizes the character and retrieves information over the web (See Para 78, 82, and figure 10-1). Carro teaches retrieving information for services and making copies documents and display with illumination or highlighting (See 145-147, 151, 173, 224, and 248). Schneider shows an example of reading bar codes with the bar-code printed on the medium (See Figure 10-6 and Para 108) and a system that converts text – to – speech (see Para 78). The barcodes recognize symbols to retrieve information on the internet. Schneider teaches recognition of an address with media with an attachment to an image read from the medium where the media can be read via the text-to-speech system (See Para 113). Schneider suggests the use of an input code device that can track fingers, finger prints mnemonic, pattern, or object identifier which can be Braille (See Para 14, 78, and claim 12), Schneider and Carro teach recognition of characters and images from a medium and then retrieving the information over the internet.

Accordingly, it would have been obvious to the skilled artisan at the time of the invention having Schneider and Carro in front of them to modify Carro to recognize barcodes and to read the characters to the user via a text to speech system. The motivation to combine Carro with Schneider comes from Schneider that a need to recognize symbols that help people to remember



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a given object and an addressing system that recognizes the symbols (See Para 15-16 and 47-50).

**Claims 8-9, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carro et al. (hereinafter Carro) U.S. Patent Publication No. 20020087598 published July 4, 2002, in view of Ma et al. (hereinafter Ma) U.S. Patent No. 6731315 filed Nov. 30, 1999. .**

With respect to **claims 8-9, 12** as indicated in the above discussion Carro teaches all the elements of claim 1.

Carro does not expressly recite the method wherein the step of presenting said retrieved data visually, comprises the further step of: magnifying the retrieved data on a screen or magnifying on a screen the electronic copy of the selected part of the physical document or a enhancing on a screen the electronic copy of the selected part of the physical document to match the user's preferred reading view.

However, Ma teaches a system that magnifies a given portion of a document by magnifying a cursor on the retrieved system. The font can be changed or a portion of the document can be highlighted (See column 3, lines 10-67). The user can configure, by selecting a menu option, how they want the information to be displayed. Ma and Carro both teach a user workstation that have a mouse to show what the user has indicated as their selections.

Accordingly, it would have been obvious to the skilled artisan at the time of the invention having Ma and Carro in front of them to modify Carro to magnify portions of a document. The motivation to combine Ma with Carro comes from within Ma to provide a cursor to allow the reader to read small text and that the system should be applicable to any browser/editor application (See column 1, lines 15-35).

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**A reference to specific paragraphs, columns, pages, or figures in a cited prior art reference is not limited to preferred embodiments or any specific examples. It is well settled that a prior art reference, in its entirety, must be considered for all that it expressly teaches and fairly suggests to one having ordinary skill in the art. Stated differently, a prior art disclosure reading on a limitation of Applicant's claim cannot be ignored on the ground that other embodiments disclosed were instead cited. Therefore, the Examiner's citation to a specific portion of a single prior art reference is not intended to exclusively dictate, but rather, to demonstrate an exemplary disclosure commensurate with the specific limitations being addressed. *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)). *In re: Upsher-Smith Labs. v. PamLab, LLC*, 412 F.3d 1319, 1323, 75 USPQ2d 1213, 1215 (Fed. Cir. 2005); *In re Fritch*, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1782 (Fed. Cir. 1992); *Merck & Co. v. Biocraft Labs., Inc.*, 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989); *In re Fracalossi*, 681 F.2d 792, 794 n.1, 215 USPQ 569, 570 n.1 (CCPA 1982); *In re Lamberti*, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976); *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).**

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN B. THERIAULT whose telephone number is (571)272-5867. The examiner can normally be reached on Mon.-Fri. 10 am - 7 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Steven B Theriault/  
Primary Examiner  
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